REMARKS

Claims 1, 2, 6-10, 12, 14, 16 and 21 are pending. Claim 20 has been cancelled without prejudice. Claims 1, 10, 12 and 16 are the only independent claims.

Claims 1, 2, 6-10, 12 and 14 were rejected under 35 U.S.C. 101 as allegedly not having utility. Applicant traverses.

In the first place, the Examiner has not met the detailed requirements of setting forth a prima facie case of a lack of utility. This test is set forth, for example, at MPEP Section 2107.02 IV. Moreover, the claims rejected clearly meet the utility requirement. In practice the utility of network method claims, computer network claims, or other computer related claims is rarely, if ever, questioned. Rejections for lack of utility are almost always limited to chemical or allegedly pharmaceutical compounds, or such similar inventions, the utility of which may not be clear from a simple description of the structure of the compound.

On the other hand, in claim 1 for example, a method for configuring a ring in a mesh network clearly has a recited utility. Among other things, *it configures a ring in a mesh network*. The claim language itself includes a statement of its utility. The fact that some hypothetical *further* possible use, such as the "steps for the utilization of the assigned node numbers," can be identified by the Examiner (see Office Action, page 2) is not a proper rationale for rejecting the claim as lacking utility. It is not required that every possible utility that can be imagined be recited in the claim.

Based on the abovementioned statement of utility in the claims, to reject such claims based on a lack of utility would require that the Examiner show, *with supporting evidence*, that the claimed invention *does not actually work*. It is requested that the Examiner carefully review the requirements set forth in MPEP Section 2107 and withdraw the rejection in the next Office Action.

Claims 16, 20 and 21 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The cancellation of claim 20 renders its rejection moot.

Claims 16 and 21 were rejected because they include limitations related to a mesh network. However, the specification makes it clear how the ring and mesh limitations relate to one another. It is believed that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is therefore respectfully requested.

Claims 1, 2, 7, 9, 10, 12, 14, 16 and 20 were rejected under 35 U.S.C. § 103 over Ye et al. ("On Joint Protection/Restoration in IP-Centric DWDM-Based Optical Transport Networks") in view of Li et al. ("Dynamic Wavelength Routing Using Congestion and Neighborhood Information") and further in view of U.S. Patent 5,815,490 (Lu). Claim 6 was rejected under 35 U.S.C. § 103 over Ye et al. in view of Li et al. and Lu, and further in view of U.S. Patent Publication 2002/0080437 (Sparks et al.). Claims 8 and 21 were rejected under 35 U.S.C. § 103 over Ye et al. in view of Li et al. and Lu, and further in view of Ramamurthy et al.

Claim 1 is directed to a ring configuration method in a mesh network consisting of a plurality of nodes, each of the nodes having a cross-connecting function, wherein a ring network (referred to as "a ring") comprising a working path and a stand-by path is configured dynamically in response to a request for setting the working path. The mesh network is a WDM (Wavelength Division Multiplex)-based optical fiber communication network.

If a new ring to be configured is identical to an existing ring using the same wavelength as that of the new ring, the same node numbers as node numbers locally assigned to nodes in the existing ring are assigned to the corresponding nodes to each node of the existing ring in the new ring, and if the new ring crosses or is adjacent to the existing ring

using in the same wavelength, local node numbers different from those of the nodes in the existing ring are assigned to the nodes in the new ring.

The Office Action again took the position that the feature described in the foregoing paragraph is taught in Lu. In particular, the Office Action took the position that "Lu teaches in FIG. 4A that a ring has a ring ID and teaches in FIG. 4D that a node has a node ID." The Office Action goes on to say: "[i]n a situation where a node belongs to a plurality of rings, it is obvious to use the ring ID together with the node ID to identify a node. That is, if a node belongs to the same ring, it has the same ring ID/node combination. For two different rings, a node common to the two rings has different ring ID/node ID combinations." See Office Action at page 4. This is essentially the same position as that taken in the previous Office Action.

As was pointed out in the previous reply, Lu's teaching of a ring ID and a node ID does not correspond to the recited limitation in claim 1 that if a new ring to be configured is identical to an existing ring using the same wavelength as that of the new ring, the same node numbers as node numbers locally assigned to nodes in the existing ring are assigned to the corresponding nodes to each node of the existing ring in the new ring, and if the new ring crosses or is adjacent to the existing ring using in the same wavelength, local node numbers different from those of the nodes in the existing ring are assigned to the nodes in the new ring, as is claimed.

In order to set forth a prima facie case of obviousness, each feature must be taught or suggested in the combination of references. Applicant finds no teaching or suggestion in Lu of this specific limitation.

In response to the above arguments, the Examiner, in the "Response to Arguments" at page 7 of the current Office Action, took the position that

> "it follows naturally that in the same ring, the node has the same ring ID and node ID. On the other hand, if the node belong[s] to two different rings, the two rings cross or [are] adjacent, and the node has different identification because the ring ID/node ID combinations are different for the same node when considered as member of the two different rings." Office Action at page 8.

However, it is clear from the above-quoted section of the Office Action that each and every word of the claim is not being accorded patentable weight. The claim does not simply recite that different identifications are used for the same node when considered as a member of two different rings. The portion of claim 1 for which Lu is relied upon reads:

> "if a new ring to be configured is identical to an existing ring using the same wavelength as that of said new ring, the same node numbers as node numbers locally assigned to nodes in said existing ring are assigned to the corresponding nodes to each node of said existing ring in said new ring, and
>
> if said new ring crosses or is adjacent to said existing ring using in the same wavelength, local node numbers different from those of the nodes in said existing ring are assigned to the nodes in said new ring."

Nothing in the cited prior art is believed to teach these limitations, and none has been pointed out. It is totally improper to paraphrase the claim feature in question, and then apply the prior art to that paraphrase. This is improperly examining the "gist" of the invention. In view of the above, it is clear that no prima facie case of obviousness has been established as to claim 1.

In summary, the feature the Office Action considers to be obvious does not correspond to what is actually recited, and there is no teaching or suggestion in Lu of the above-mentioned feature actually recited in claim 1. For at least this reason, independent claim 1 is believed clearly distinguishable over the cited art.

Each of other independent claims recites a substantially similar feature and is believed to distinguish over the cited art for at least the same reasons. The other references do not remedy the above-mentioned deficiency of the art discussed above as references against the independent claims.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

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Respectfully submitted,

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